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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/614,856
Filing Date: July 09, 2003
Appellant(s): FARKAS ET AL.

Timothy B. Kang
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed February 23, 2009 appealing from the Office action mailed September 23, 2008.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is incorrect. A correct statement of the status of the claims is as follows:

Claims 43-54 withdrawn from consideration as not directed to the elected invention due to restriction by original presentation as detailed in the Final Office Action.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is substantially correct. The changes are as follows: Appellant's statement of whether claims 43-54 should have been withdrawn from consideration as being directed to a non-elected invention is a petitionable matter and not an appealable issue.

(7) Claims Appendix

A substantially correct copy of appealed claims 1-12 and 37-54 appears on page 20 of the Appendix to the appellant's brief. The minor errors are as follows: Claims 43-54 should be labeled as withdrawn as they are directed to non-elected invention restricted by original presentation.

(8) Evidence Relied Upon

5,546,315	Kleinschnitz	8-1996
2001/0020935 A1	Gelbman	9-2001
5,434,775	Sims	7-1995
2003/0106937 A1	Creager	6-2003

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. **Claims 41-42** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
3. **Claim 41** recite the limitations "wherein the reader device comprises an imaging device positioned on one of a ceiling and a wall of the room". The limitation as phrased

is viewed to be vague and indefinite because it is unclear what the applicant is referring to. It is unclear if the applicant is implying that the imaging device is positioned on a ceiling or a wall of the room. Claim discloses an imaging device limiting the position of the imaging device to one location and claim recites positioning the device on the wall and ceiling. It is not clear if the imaging device is positioned on the ceiling alone, on the ceiling and one of the walls of the room, or on a wall of the room alone. Applicant is requested to construct claims eliminating ambiguity and clarifying what he is referring to.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. **Claims 1-10 and 37-40** are rejected under 35 U.S.C 103(a) as being unpatentable over Kleinschnitz (US Pat No. 5,546,315) in view of Gelbman (US Publication No. 2001/0020935 A1).

6. Regarding claim 1, Kleinschnitz discloses a system comprising: a plurality of identification devices affixed to respective associated components, said plurality of identification devices being configured to communicate identification information relating to the respective associated components (Column 8 lines 12-29); a reader device configured to substantially autonomously receive the identification information from the

identification device (Column 8 lines 12-29); means for identifying the locations of the identification devices from the identification information received by the reader device from the plurality of identification devices (Column 4 lines 33-44); and a controller configured to communicate with the reader device and compile the identification information received from the reader device and to communicate with the means for identifying the locations of the identification devices to maintain an inventory of the components (Column 8 lines 12-29, Column 9 lines 22-36).

7. Kleinschnitz fails to explicitly disclose a system wherein identification devices comprise respective digital displays configured to display the identification information.

8. However, Gelbman discloses a system wherein identification devices comprise respective digital displays configured to display the identification information (Abstract, Paragraph [0010]);

9. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use the teachings of Gelbman in the device of Kleinschnitz reference to include a system wherein identification devices comprise respective digital displays configured to display the identification information, for the advantage of providing a human or machine readable visual display of identification information (Gelbman, Paragraph [0007]).

10. Regarding claim 2, Kleinschnitz discloses a system further comprising: a memory accessible by said controller, wherein said controller is configured to store the identification information and the locations of the identification devices in the memory (Column 8 lines 12-29).

11. Regarding claim 3, Kleinschnitz discloses a system wherein the components comprise electronic devices for use in data centers (Abstract).
12. Regarding claim 4, Kleinschnitz discloses a system wherein the identification devices comprise labels affixable to the components, said labels having identifying indicia displayed thereon (Column 8 lines 12-29).
13. Regarding claim 5, Kleinschnitz discloses a system wherein the identifying indicia comprises at least one of text, barcode, or a display on a screen (Column 8 lines 12-29).
14. Regarding claim 6, Kleinschnitz discloses a system wherein the identification devices comprise relatively distinctive identifying characteristics, said characteristics comprising at least one of color, composition, and style (Column 8 lines 12-29, any physical identification device comprises characteristics of color, composition and style).
15. Regarding claim 7, Kleinschnitz discloses a system further comprising: a data transmitting device configured to transmit data to the identification devices; and wherein the identification devices comprise electronic apparatuses configured to receive data from the data transmitting device (Figure 4, Column 7 line 62 – Column 8 line 29).
16. Regarding claim 8, Kleinschnitz discloses a system wherein the reader device comprises at least one of an imaging device, an infrared reader, and an apparatus configured to wirelessly communicate with the identification devices (Column 8 lines 12-29, bar code reader reads on infrared reader).

17. Regarding claim 9, Kleinschnitz discloses a system wherein the reader device comprises an information gathering device located on at least one of a wall, ceiling, or floor of the room (Column 8 lines 12-38).
18. Regarding claim 10, Kleinschnitz discloses a system further comprising: a robotic device having a movable arm and being configured to travel through the room, wherein the reader device is attached to the movable arm of the robotic device (Column 3 lines 42-49).
19. Regarding claims 37-39, Kleinschnitz fails to explicitly disclose a system wherein each of the plurality of identification devices further comprises respective input modules configured to enable receipt of the identification information of the respective associated components.
20. However, Gelbman discloses a system wherein each of the plurality of identification devices further comprises respective input modules configured to enable receipt of the identification information of the respective associated components (Abstract, Paragraph [0010]).
21. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use the teachings of Gelbman in the device of Kleinschnitz reference to include a system wherein each of the plurality of identification devices further comprises respective input modules configured to enable receipt of the identification information of the respective associated components, for the advantage of providing a human or machine readable visual display of identification information (Gelbman, Paragraph [0007]).

22. Regarding claim 40, Kleinschnitz fails to explicitly disclose a system wherein each of the plurality of identification devices further comprises respective output modules configured to wirelessly transmit the identification information.

23. However, Gelbman discloses a system wherein each of the plurality of identification devices further comprises respective output modules configured to wirelessly transmit the identification information (Abstract, Paragraph [0010]);

24. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use the teachings of Gelbman in the device of Kleinschnitz reference to include a system wherein each of the plurality of identification devices further comprises respective output modules configured to wirelessly transmit the identification information, for the advantage of providing a human or machine readable visual display of identification information (Gelbman, Paragraph [0007]).

25. **Claims 11-12** are rejected under 35 U.S.C 103(a) as being unpatentable over Kleinschnitz (US Pat No. 5,546,315) in view of Gelbman (US Publication No. 2001/0020935 A1) further in view of Sims et al. (US Pat No. 5,434,775).

26. Regarding Claim 11, Kleinschnitz fails to explicitly disclose a system wherein the means for identifying the locations of the identification devices comprises labels affixed at various positions of the room, said labels including indicia identifying the locations of the labels.

27. However, Sims discloses a system wherein the means for identifying the locations of the identification devices comprises labels affixed at various positions of the room, said labels including indicia identifying the locations of the labels (Abstract);

28. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use the teachings of Sims in the device of Kleinschnitz reference to include a system wherein the means for identifying the locations of the identification devices comprises labels affixed at various positions of the room, said labels including indicia identifying the locations of the labels, for the advantage of tracking the locations of devices in stored in various areas (Sims, Column 1 lines 5-9).

29. Regarding Claim 12, Kleinschnitz fails to explicitly disclose a system wherein the means for identifying the locations of the identification devices comprises location aware devices configured to determine their locations with respect to other location aware devices and to a fixed reference point.

30. However, Sims discloses a system wherein the means for identifying the locations of the identification devices comprises location aware devices configured to determine their locations with respect to other location aware devices and to a fixed reference point (Abstract, Column 1 lines 50-66).

31. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use the teachings of Sims in the device of Kleinschnitz reference to include a system wherein the means for identifying the locations of the identification devices comprises location aware devices configured to determine their locations with respect to other location aware devices and to a fixed reference point, for

the advantage of tracking the locations of devices in stored in various areas (Sims, Column 1 lines 5-9).

32. **Claims 41-42** are rejected under 35 U.S.C 103(a) as being unpatentable over Kleinschnitz (US Pat No. 5,546,315) in view of Gelbman (US Publication No. 2001/0020935 A1) further in view of Creager et al. (US Publication No. 2003/0106937 A1).

33. Regarding claims 41-42, Kleinschnitz fails to explicitly disclose a system wherein the reader device comprises an imaging device positioned on one of a ceiling and a wall of the room, wherein the imaging device is configured to obtain images of the plurality of identification devices, and wherein the means for identifying is further configured to read the identification information from the images of the plurality of the identification devices.

34. However, Creager discloses a system wherein the reader device comprises an imaging device positioned on one of a ceiling and a wall of the room, wherein the imaging device is configured to obtain images of the plurality of identification devices, and wherein the means for identifying is further configured to read the identification information from the images of the plurality of the identification devices (Abstract, Paragraph [0025]).

35. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use the teachings of Gelbman in the device of Kleinschnitz reference to include a system wherein the reader device comprises an imaging device positioned on one of a ceiling and a wall of the room, wherein the imaging device is configured to obtain images of the plurality of identification devices,

and wherein the means for identifying is further configured to read the identification information from the images of the plurality of the identification devices, for the advantage of providing a visually identifying and recognizing of identification information.

(10) Response to Argument

Argument A: The examiner erred in withdrawing claims 43-54 from consideration as being directed to a non-elected invention due to restriction by original presentation.

In response to applicant's arguments, it is noted that objections to a restriction requirement is a petitionable matter and not an appealable matter. The MPEP cites:

818.03(c) [R-3] Must Traverse To Preserve Right of Petition
37 CFR 1.144. Petition from requirement for restriction.

****>**After a final requirement for restriction, the applicant, in addition to making any reply due on the remainder of the action, may petition the Director to review the requirement. Petition may be deferred until after final action on or allowance of claims to the invention elected, but must be filed not later than appeal. A petition will not be considered if reconsideration of the requirement was not requested (see § 1.181).

If applicant does not distinctly and specifically point out supposed errors in the restriction requirement, the election should be treated as an election without traverse and be so indicated to the applicant by use of form paragraph 8.25.02

The line of demarcation between appealable matters for the Board of Patent Appeals and Interferences (Board) and petitionable matters for the ****>**Director of the U.S. Patent and Trademark Office (Director)< should be carefully observed. The Board will not ordinarily hear a question ****>**that< should be decided by the ***>**Director on petition<, and the ***>**Director< will not ordinarily entertain a petition where the question presented is ****>**a matter appealable to the Board<. **However, since 37 CFR 1.181(f) states that any petition not filed within 2 months from the action complained of may be dismissed as untimely and since 37 CFR 1.144 states that petitions from restriction requirements must be filed no later than appeal, petitionable matters will rarely be present in a case by the time it is before the Board for a decision. In re Watkinson, 900 F.2d 230, 14 USPQ2d 1407 (Fed. Cir. 1990).**

Argument B: The examiner erred in rejecting claims 41 and 42 under 35 U.S.C. 112, second paragraph.

In response, the Examiner respectfully disagrees. Claim 41 recite the limitations "wherein the reader device comprises an imaging device positioned on one of a ceiling and a wall of the room". The limitation as phrased is viewed to be vague and indefinite because it is unclear what the applicant is referring to. It is unclear if the applicant is implying that the imaging device is positioned on a ceiling or a wall of the room. Claim discloses an imaging device limiting the position of the imaging device to one location and claim recites positioning the device on the wall and ceiling. It is not clear if the imaging device is positioned on the ceiling alone, on the ceiling and one of the walls of the room, or on a wall of the room alone.

Argument C: Kleinschnitz fails to *teach means for identifying the locations of the identification devices from the identification information received by the reader device from the plurality of identification devices.*

In response, the Examiner respectfully disagrees. Kleinschnitz discloses identifying the locations of the identification devices from the identification information received by the reader device from the plurality of identification devices (Column 4 lines 33-44, Column 8 lines 12-29). In Particular, Column 8 lines 21-29 disclose using a bar code reader and scanner to read each cartridge label as cartridges are added to inventory, recording the label information read and the inventory location for the media cartridge, and identifies the locations of the inventory from the identification information

of the label. Furthermore, it is noted that the features upon which applicant relies in the arguments (i.e., **the location information provided on the identification devices may include the location of the identification devices with respect to particular racks or they may comprise coordinate locations**) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Argument D: It would not have been obvious to one of ordinary skill in the art to modify the bar code labels in Kleinschnitz to comprise the electronic labels disclosed in Gelbman.

36. In response, the Examiner respectfully disagrees. The examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, it would be extremely advantageous to incorporate the teachings of Gelbman into the disclosure of Kleinschnitz, for the purpose of providing a human or machine readable visual display of identification information as disclosed in [0007] of Gelbman. Therefore, in view of the above evidence, the combination of

Kleinschnitz in view of Gelbman still meet the scope of the limitations as currently claimed.

Furthermore, KSR forecloses the argument that a *specific* teaching, suggestion, or motivation is required to support a finding of obviousness. See the recent Board decision *Ex parte Smith*, --USPQ2d--, slip op. at 20, (Bd. Pat. App. & Interf. June 25, 2007) (citing *KSR*, 82 USPQ2d at 1396).

Argument E: With respect to dependent claims 11 and 12, Sims fails to *disclose that labels include indicia identifying the locations of the labels*.

In response, the Examiner respectfully disagrees. It appears that applicant is arguing that the combination of Kleinschnitz, Gelbman, and Sims fails to teach that a plurality of identification devices comprise respective digital displays configured to display indicia identifying the locations of the identification devices. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., a plurality of identification devices comprise respective digital displays **configured to display indicia identifying the locations of the identification devices**) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Furthermore, Sims teaches labels affixed to devices at various positions (Abstract), said labels including indicia identifying the locations of the labels (Abstract, Column 15 line 56 – Column 16 line 13). In addition, the combination of the tags (labels) taught by Sims in Combination with the digital label

taught by Gelbman reads on a plurality of identification devices comprising respective digital displays.

Argument F: Creager fails to teach that identifying is further configured to read the identification information from the images of the plurality of the identification devices.

In response, the Examiner respectfully disagrees. Creager teaches an imaging device that collects image information from a label reader that processes the image information to gather information about each readable cartridge label (Paragraphs [0023] – [0025]).

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/Faris Almatrahi/

Examiner, Art Unit 3627

/F. Ryan Zeender/

Supervisory Patent Examiner, Art Unit 3627

/Matthew S Gart/

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